

REMARKS

Claims 1, 4, 5, 8-13, 16, 17 and 19-21 are pending in the present application. Claims 1, 4, 5 and 8 are herein amended. Claim 21 is herein added. No new matter has been presented.

Claims 10-13 and 16 have been withdrawn from consideration.

Interview

Applicants wish to thank the Examiner for the helpful and courteous telephone interview conducted on April 20, 2011. Applicants' separate record of the substance of the interview is discussed herein. During the telephone interview, Applicants' representatives and the Examiner discussed the present application, Applicants' proposed claim amendments, the basis for the current rejections and the cited art.

Rejection under 35 U.S.C. §103

Claims 1, 4-5, 7-9, 17 and 19-20 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Atagi (JP2000214324A) in view of Miyazawa et al. (U.S. Patent Application Publication No. 2002/0191287). Applicants respectfully traverse this rejection.

Applicants respectfully traverse this rejection and hold that a *prima facie* case of obvious has not been established. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." See MPEP §2141. Applicants respectfully hold that there is no logical and reasonable basis to combine the cited art so as to achieve the presently claimed optical film.

During the interview, the it was explained to Applicants' representatives that a skilled

artisan would be motivated by the combination of the cited art to modify the TAC film (22) of Atagi by extending it beyond the adhesive layer (23) in view of the disclosure of the secondary reference, Miyazawa, wherein the spacer/adhesive (425) is present within the outer side edges of the base plate (421) and the protection plate (423). See Atagi, Figure 6; See also Miyazawa, Figure 3. The Examiner clarified that a skilled artisan would have been motivated to achieve this configuration to ensure protection of the adhesive layer (23) of Atagi.

Applicants respectfully disagree. In the art of optical films, a skilled artisan would not be motivated to ensure the protection of an adhesive layer at the risk of damaging an optical component. An adhesive assists with holding the optical components of an optical film together. A skilled artisan may consider the configurations and protection of said the optical components, such as a first and second optical film, within the optical device of greater importance than the adhesive component within said optical device. The optical components may have a greater impact on the resulting optical device than the adhesive component. Thus, there is no logical reason or motivation for a skilled artisan to extend an optical component beyond an adhesive layer to ensure protection of the adhesive layer at the expense of potentially damaging said optical component. Damage may result from transport of the resulting optical device.

Applicants respectfully hold that there is no logical reason or motivation for a skilled artisan to extend the TAC film (22) of Atagi beyond the adhesive layer (23) of Atagi in light of the disclosure of Miyazawa.

In the Office Action, it was asserted “Miyazawa teaches an adhesive optical film...comprising a first adhesive layer (silicone adhesive 425, paragraph [0086]).” See Office Action, paragraph 7. It was also asserted that it would have been “obvious to one of ordinary skill in the art at the time of the invention to include at least a portion of an outer side edge of the first adhesive layer of Miyazawa located on the inside of an outer side edge of a first optical film and located on the inside of an outer side edge of a layer A of a second optical film to seal and enclose layers (Miyazawa, paragraph [0093]).” See Office Action, paragraph 8.

Applicants respectfully hold that this reasoning does not provide a logical reason with some rational underpinning to support the legal conclusion of obviousness.

Paragraph [0093] of Miyazawa discloses the relationship of the protection plate (423), the adhesive (424) and the birefringent portion (424), so as to seal and enclose the birefringent portion (424). According to Miyazawa, “the protection plate 423 covering the birefringent portion 422 is provided and the *birefringent portion 422 is sealed and enclosed by the silicone adhesive 424 and the protection plate 423*, deterioration of the rib 422A can be prevented.” (emphasis added) The sealing and enclosing feature of Miyazawa is the sealing and enclosing of the birefringent portion (422), i.e. an optical component. Miyazawa discloses, teaches and suggest sealing and enclosing optical components by forming an adhesive layer on the outside edges. There is no reason or motivation based on the cited art to seal and enclose an adhesive layer between two optical components. Based on the disclosure of Miyazawa, there is no reason for a skilled artisan to seal and enclose an adhesive layer between the presently claimed first optical film and a layer A.

The disclosure of Miyazawa does not overcome the deficiencies of the primary reference, Atagi.

Moreover, the reasoning of “seal and enclose layers” may provide a logical reason for a skilled artisan not to achieve the presently claimed adhesive optical film. The cited art may teach away from the presently claimed invention. Atagi discloses in Figure 6, an entire area of an adhesive layer sandwiched between a first optical film and second optical film. In Miyazawa, the adhesive layer is present in between the protection plate and the base plate and is present along the outside edges of the protection plate and the base plate. See Miyazawa, Figure 3. Therefore, even if a skilled artisan were to combine the disclosure of Atagi in view of Miyazawa, motivated to seal and enclose an optical component, a skilled artisan would logically form an optical film wherein the adhesive layer is present along the outside edges of the first and second optical films. This hypothetical arrangement would achieve “seal and enclosure [of the] layers”, as illustrate in figure 3 of Miyazawa, component (424).

It is noted that the spacer/adhesive (425) component of Miyazawa is cited in the Office Action as rendering obvious the presently claimed adhesive layer. However, the section of Miyazawa cited in the Office Action to support the logical reason for combining the cited art is in reference to the adhesive (424) component. Applicants respectfully hold that based on the entire disclosure of Miyazawa and Atagi, a skilled artisan would not have any reason or motivation to achieve the presently claimed adhesive optical film, wherein a first optical film is adhered directly upon a first surface of a first adhesive layer and a layer A is adhered directly upon a second surface of the first adhesive layer, wherein a third surface of the first adhesive layer is an

outer side edge of the first adhesive layer and the third surface of the first adhesive layer is located on the inside of an outer side edge of the first optical film and the third surface of the first adhesive layer is located on the inside of an outer side edge of the layer A and wherein the entire area of the first adhesive layer is sandwiched between the first optical film and the layer A.

Applicants respectfully hold that a skilled artisan at the time of invention would not have considered it obvious to modify Atagi in view of Miyazawa since the proposed combination of the cited art would destroy the operability of the cited art. A feature of Miyazawa is the spacer/adhesive (425) feature which creates a gap. See Figures 3 and 7 of Miyazawa, wherein a gap is formed between the protection plate (423) and the birefringent portion (422) by the presence of the spacer/adhesive (425). See also Miyazawa, paragraph [0086], “spacer 425...so that the protection plate 423 is spaced apart from the birefringent portion 422....” The formation of a spacer/adhesive, as disclosed in Miyazawa, to the optical film of Atagi would destroy the operability of the film of Atagi. Each of the components of Atagi are disposed directly on top of one another. This is a feature of the device of Atagi. The formation of a spacer/adhesive, as disclosed in Miyazawa, would destroy this feature of Atagi and render the resulting device inoperable. “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See MPEP §2143.01, Section V. “If references taken in combination would produce a ‘seemingly inoperative device’, we have held that such references teach away from the combination and thus cannot serve as predicates for a *prima facie* case of obviousness”

In re Spinnoble, 56 C.C.P.A. 823, 405 F.2d 578, 587, 10 U.S.P.Q. (BNA) 237, 244 (CCPA 1969); see also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984).” Cited by *McGinley v Franklin Sports, Inc.*, 262 F.3d 1339, 1354, 60 U.S.P.Q. 2d (BNA) 1001 (Fed. Cir. 2001). Applicants respectfully hold that since the spacer/adhesive feature of Miyazawa would render the film of Atagi inoperability, it would not be obvious to a skilled artisan to combine the cited art.

For at least the reasons herein discussed, Applicants respectfully request reconsideration and withdrawal of this rejection. Favorable reconsideration is earnestly solicited.

A feature of claim 21 of the present application is that the presently claimed layer A is a release film. The cited art fails to render claim 21 of the present application obvious. The base film (421) of Miyazawa and the TAC film (22) of Atagi are components of the optical devices of the cited art and would not be considered by a skilled artisan at the time of invention to be a release film. Therefore, in the cited references, the presently claimed layer A is not configured to be released from the completed products.

Applicants respectfully request reconsideration and withdrawal of the obviousness rejection.

Conclusion

In view of the above, Applicants respectfully submit that the claimed invention is allowable and ask that the rejection under 35 U.S.C. §103 be reconsidered and withdrawn. Applicants respectfully submit that this case is in condition for allowance and allowance is respectfully solicited.

If any points remain at issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the local exchange number listed below.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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